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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,336	07/14/2003	Mark William Mahoney	2250.08088	6797
21000	7590	03/25/2005	EXAMINER	
DECKER, JONES, MCMACKIN, MCCLANE, HALL & BATES, P.C. BURNETT PLAZA 2000 801 CHERRY STREET, UNIT #46 FORT WORTH, TX 76102-6836			LAZO, THOMAS E	
			ART UNIT	PAPER NUMBER
			3745	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/619,336

**Applicant(s)**

MAHONEY, MARK WILLIAM

**Examiner**

Thomas E. Lazo

**Art Unit**

3745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,8 and 9 is/are rejected.
- 7) ☒ Claim(s) 3,5 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Munk (2,465,600). Munk discloses a downhole pump with a barrel 7 having a first end and a second end, with a standing valve 8 located near the second end and a guide coupled to the first end, a plunger 9 located in the barrel 7 and structured and arranged to reciprocate therein, wherein the guide includes a guide 6 having a first end structured and arranged to couple to the barrel 7 of the pump, a bushing 4,5 having a bushing stop at a second end, the guide 6 and bushing 4,5 are coupled together such that the distance between the first and second ends can be adjusted, the guide 6 and bushing 4,5 have a passage therethrough for receiving an extension member 12, the guide 6 and bushing 4,5 are coupled together by threads, the guide 6 has first threads and bushing 4,5 has second threads, the plunger 9 is connected to the extension member 12, the bushing 4,5 is located on the extension member 12 and structured and arranged to contact a free end of the guide 6, and the free end of the guide is adjustable in distance relative to the first end of the barrel 7.

Regarding claims 8 and 9, Munk discloses a method of assembling a pump by inserting a plunger and an extension member of the plunger into a barrel, the plunger forming a compression

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chamber inside of the barrel and the extension member extending out of the barrel, coupling a guide onto the end of the barrel such that the extension member passes through the guide, the guide having a free end, the free end of the guide being spaced from the barrel end by a distance, coupling a bushing to the extension member, the bushing being structured and arranged to contact the free end of the guide, adjusting the distance of the free end of the guide so as to adjust the size of the compression chamber, and retaining the position of the free end of the guide.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munk, as applied to claim 1 above, in view of applicant's admitted prior art figure 3. Munk discloses all of the claimed subject matter except for the guide having openings from the passage to an outside diameter.

Applicant's admitted prior art in figure 3 teaches for a downhole pump with a guide 43 that has openings from the passage to an outside diameter for the purposes of allowing the fluid to exit the pump into the tubing.

Since Munk and prior art figure 3 are both downhole pumps, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the

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downhole pump of Munk, based on the teachings of prior art figure 3, to include openings from the passage to an outside diameter for the purposes of allowing the fluid to exit the pump into the tubing.

***Allowable Subject Matter***

Claims 3, 5, and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Prior Art***

Prior art made of record but not relied upon is considered pertinent to Applicant's disclosure and consists of four patents.

Williams (4,621,567), Stanton (4,501,119), Berkley (3,097,605), and Johnson (2,958,237) are cited to show downhole pump stroke adjustment mechanisms.

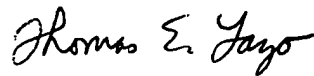
***Contact Information***

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Thomas Lazo whose telephone number is (571) 272-4818. The examiner can normally be reached on Monday-Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Edward Look, can be reached on (571) 272-4820. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to status of this application or proceeding should be directed to the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.



Thomas E. Lazo  
Primary Examiner  
Art Unit 3745

TEL  
March 17, 2005